

**S/N 10/648,125**

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant(s): Steve Grove et al.

Examiner: Cam Truong

Serial No.: 10/648,125

Group Art Unit: 2169

Filed: August 25, 2003

Docket No.: 2043.102US1

Customer No.: 49845

Confirmation No.: 3210

Title: METHOD AND SYSTEM TO GENERATE A LISTING IN A NETWORK-BASED COMMERCE SYSTEM

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**APPEAL BRIEF UNDER 37 CFR § 41.37**

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The Appeal Brief is presented in response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on April 16, 2010 and further in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on March 4, 2010, from the Final Rejection of claims 1-7, 9-19, 21-29, 31-36 and 39-45 of the above-identified application, as set forth in the Office Action mailed on January 4, 2010.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of \$540.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellants respectfully request consideration and reversal of the Examiner's rejections of the pending claims.

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

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## **1. REAL PARTY IN INTEREST**

The real party in interest of the above-captioned patent application is the assignee, eBay Inc., as evidenced by the Assignment from the Inventors recorded on August 25, 2003, at Reel 014445, Frames 0182-0184.

## **2. RELATED APPEALS AND INTERFERENCES**

There are no other Appeals or interferences known to Appellants that will have a bearing on the Board's decision in the present Appeal.

### **3. STATUS OF THE CLAIMS**

The present application was filed on August 25, 2003 with claims 1-34. In response to a Final Office Action mailed on January 9, 2006, Appellants canceled claims 8, 20 and 30, and added new claims 37 and 38. In a response to a Non-Final Office Action mailed December 7, 2006, Appellants canceled claims 37 and 38. In a response to a Non Final Office Action mailed on February 21, 2008, Appellants added new claims 39-41. In a response to a Final Office Action mailed December 4, 2008, Appellants added new claims 42-45. A Final Office Action (hereinafter "*the Final Office Action*") was mailed on January 4, 2010. Claims 1-7, 9-19, 21-29, 31-36 and 39-45 stand twice rejected, remain pending, and are the subject of the present Appeal.

#### **4. STATUS OF AMENDMENTS**

No amendments have been made subsequent to the Final Office Action dated January 4, 2010.

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## **5. SUMMARY OF CLAIMED SUBJECT MATTER**

Aspects of the present inventive subject matter include, but are not limited to, a method and system to generate a listing in a networked-based commerce system.

In operation, a seller in an ecommerce system (10, Fig. 1, 40, Fig. 2), desires to list an item, (paragraph [00015], lines 4-8), for sale on the system. Importantly, in practice only a seller lists items for sale. Buyers do not list items for sale. This point will be important in the discussion below.

In the application, the seller sends the ecommerce system the category of item for which the seller desires to generate a listing. The category of item is received from the seller by the system (102, 104, Fig. 4; paragraph [00024]; and originally filed claim 1, line 3).

The system verifies that the category is capable of having listings automatically generated for it (112, Fig. 5; paragraph [00027]).

The seller then sends listing data that identifies the item to be sold (114, Fig. 5; paragraph [00027]).

The system uses the listing data to search a database of listing data to locate listings for similar items that have been posted for sale on the system (originally filed claims 8, 20, 30).

The system also searches its database for item attribute data (116, Fig. 5; paragraphs [00027], [00028]).

The system presents the plurality of similar listings, and the attribute data, to the seller (118, Fig. 5; paragraphs [00027], [00029]).

The seller then selects one of the listings that lists an item similar to that which the seller wants to generate a listing for (118, Fig. 5; 132, Fig. 6; paragraphs [00034]; originally filed claims 8, 20, 30).

The system then generates a proposed listing for the seller based on the listing data and the seller's selection of the similar item, and sends the proposed listing to the seller for preview purposes, (138, Fig. 6; paragraphs [00030], [00036], [00037]).

The seller can then modify the proposed listing in order to create the seller's listing for the item, (paragraphs [00024], [00029], [00038], originally filed claims 6, 18, 28).

Finally, the listing that has been created is posted to the ecommerce system. Once the listing is posted, the item is then offered for sale (paragraphs [00024], [00029], [00037]; originally filed claims 1, 13, 23, 24; abstract).

The meaning of “listing” can be understood from paragraph [0050] of the application:

Listing creation applications 60 allow sellers  
conveniently to author listings pertaining to goods  
or services that they wish to transact via the  
commerce system ....

### **THE INDEPENDENT CLAIMS**

The independent claims are listed below. Because of the length of the claims, and the length and location of the claim limitations cited and rejected in the Final Office Action, independent claim 1 has each limitation identified with an ‘L’ number for ease of reference in the discussion that follows.

#### **INDEPENDENT CLAIM 1**

1. A method of generating a listing in a network-based commerce system, the method comprising:

(L1) receiving a category selection from a seller ([00027, lines 1-6], Originally filed claims 1, 13, 23, Abstract);

(L2) verifying the category supports automated generation for proposed listings ([00027, lines 1-6]);

(L3) receiving listing identification data from a seller, the listing identification data capable of being used to identify a good or service (114, Fig. 5; [0005, line 3], [00027, lines 6-8]);

(L4) searching a database of listing data using the listing identification data to locate a plurality of similar listings posted within a network-based commerce system ([00028, lines 5-8], originally filed claims 8 (lines 2-3), 20 (lines 2-3), 30 (lines 1-2));

(L5) searching the database to locate attribute data ([00013, line 1], [00027, lines 10-11]);



(L6) providing information to present the plurality of similar listings and the attribute data to the seller ([00027, lines 10-17], [00029, lines 5-7], [00034, lines 6-10], [00035, lines 1-5]);

(L7) receiving an indication from the seller selecting a selected listing from the plurality of similar listings ([00034, lines 6-12]);

(L8) generating a proposed listing to present to the seller, the proposed listing including listing data from the selected similar listing ([00035, lines 1-3]);

(L9) providing information to present a preview of the proposed listing to the seller ([00035, lines 3 to end]);

(L10) allowing the seller to modify the listing data of the proposed listing to create a listing ([00038, all lines], [00039, all lines], [00040, all lines]); and

(L11) posting the listing in a database of the network-based commerce system, the listing, once posted, representing an offering of the good or service for sale ([00024, lines 10-12], [00037, lines 1-4]).

### **INDEPENDENT CLAIM 13**

13. A machine-readable medium including instructions that, when executed by a machine, cause the machine to:

receive a category selection from a seller ([000027, lines 1-6], Originally filed claims 1, 13, 23, Abstract);

verify the category supports automated generation for proposed listings ([00027, lines 1-6]);

receive listing identification data from a seller requesting posting of a listing on a network-based commerce system, the listing identification data capable of being used to identify a good or service in the category ([00005, line 3], [00027, lines 6-8]);

search a database of listing data using the listing identification data to locate a plurality of similar listings posted within a network-based commerce system ([00028, lines 5-8], originally filed claims 8 (lines 2-3), 20(lines 2-3), 30(lines 1-2));

receive an indication from the seller to select a selected listing from the plurality of similar listings ([00034, lines 6-12]);

searching the database to locate attribute data ([00013, line 1], [00027, lines 10-11]);

providing information to present a preview of the plurality of similar listings and the attribute data to the seller ([00035, lines 3 to end]);

generate a proposed listing to present to the seller, the proposed listing including listing data from the selected similar listing ([00035, lines 1-3]);

providing information to present the proposed listing to the seller ([00035, lines 3 to end]);

allow the seller to modify the listing data in the proposed listing to create the listing ([00038, all lines], [00039, all lines], [00040, all lines]); and

post the listing in a database of the network-based commerce system, the listing, once posted, representing an offering of a good or service for sale ([00024, lines 10-12], [00037, lines 1-4]).

### **INDEPENDENT CLAIM 23**

23. A network-based commerce system, which includes at least one server to:
- receive listing identification data from a seller requesting posting of a listing on a network-based commerce system, the listing identification data capable of being used to identify a good or service (114, Fig. 5; [0005, line 3], [00027, lines 6-8]);
- search a database of listing data using the listing identification data to locate a plurality of similar listings posted within a network-based commerce system ([00028, lines 5-8], originally filed claims 8 (lines 2-3), 20 (lines 2-3), 30 (lines 1-2));
- receive an indication from the seller to indicate a selection of a selected listing from the plurality of similar listings ([00034, lines 6-12]);
- generate a proposed listing to present to the seller, the proposed listing including listing data from the selected similar listing ([00035, lines 1-3]);
- allow the seller to modify the listing data in the proposed listing to create the listing ([00038, all lines], [00039, all lines], [00040, all lines]); and
- post the listing in a database of the network-based commerce system, the listing, once posted, representing sales offering of a good or service ([00024, lines 10-12], [00037, lines 1-4]).

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**6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL***The Rejection of Claims Under § 103*

Claims 1-4, 7, 9, 13-16, 19, 21, 23-26, 29, 31, 35, 39-41 and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. (U.S. Publication No. 2003/0036964, hereinafter; “Boyden”) in view of Dicker et al. (U.S. Publication No. 2003/0105682, hereinafter; “Dicker”).

Claims 5-6 and 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden in view of Dicker and further in view of Grefenstette et al. (U.S. Patent No. 6,928,425, hereinafter; “Grefenstette”).

Claims 10 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden in view of Dicker and further in view of Maze et al. (U.S. Patent No. 6,216,264).

Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden in view of Dicker and further in view of Ortega et al. (U.S. Patent No. 6,144,958, hereinafter; “Ortega”).

Claims 27-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden in view of Dicker and further in view of Grefenstette.

Claim 32 was rejected under 35 U.S.C. § 103(a) as being unpatentable over ??? in view of Dicker and further in view of Maze et al. (U.S. Patent No. 6,216,264, hereinafter; “Maze”).

Claims 33-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden in view of Dicker and further in view of Ortega.

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Claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden in view of Dicker and further in view of Bezos et al. (U.S. Patent No. 6,029,141, hereinafter; “Bezos”).

Claims 42-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden in view of Dicker and further in view of Sick et al. (U.S. Publication No. 2003/0216971, hereinafter; “Sick”).

### **CLAIM GROUPS**

Independent claims 1 and 13, and their dependent claims, will constitute Claim Group I and will be argued together.

Independent claim 23, and its dependent claims, will constitute Claim Group II and will be argued separately from Group I.

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## **7. ARGUMENT**

### **CLAIM GROUP I**

Claims 1 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. (U.S. Publication No. 2003/0036964, hereinafter, “Boyden”) in view of Dicker et al. (U.S. Publication No. 2003/0105682, hereinafter, “Dicker”).

#### **With regard to claim 1**

Applicants respectfully assert that Dicker does not teach the limitations of claim 1 that the Final Office Action alleges Dicker teaches. Further, even if Dicker did teach the foregoing limitations, Applicants believe the various features of Dicker and Boyden could not be combined to achieve what is claimed without significant modifications. Therefore, a skilled artisan would not have been motivated to combine the various elements described in the references in the manner proposed by the Examiner.

### **The Rejections Do Not Make Out A Prima Facie Case Of Obviousness**

#### **BOYDEN IN VIEW OF DICKER**

The Final Office Action states:<sup>1</sup>

Boyden does not explicitly teach the claimed limitation “(Limitation (L1)) receiving a category selection from a seller; (Limitation (L2)) verifying the category supports automated generation for proposed listings; (Limitation (L7)) receiving an indication from the seller selecting a selected listing from the plurality of similar listings”. (Explanatory (L) references added)

Assuming, for the sake of argument, that the Final Office Action is correct and that Boyden does teach all claim limitations except Limitations (L1), (L2), and (L7), Applicants will demonstrate, next below, that Dicker fails to teach at least limitations (L1) and (L2) which the Final Office Action alleges Dicker teaches, each of which is required to meet claim 1. Therefore if Boyden and Dicker were combined as suggested in the Final Office Action, at least

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<sup>1</sup> See Final Office Action at Page 11, line 20 to Page 12, line2

two limitations of claim 1 would be missing from the combination, and a *prima facie* case of obviousness is not made out.

Further, even if Dicker did teach Limitations (L1), (L2), and (L7), the discussion that follows will show that these limitations cannot properly be combined with the teachings of Boyden under 35 U.S.C. § 103.

***Dicker Fails to Teach Limitations (L1) and (L2)***

As to the teachings of Dicker, the Final Office Action states:<sup>2</sup>

“Dicker teaches:

the user selects a specific category such as ‘non-fiction’ from a drop down menu 202 to require category-specific recommendations. Designating a specific category causes items in all other categories to be filled out (paragraph 0169). (Presumably, this is limitation (L1).) (Emphasis and explanatory (L) reference added)

The selected category is verified to support automated generation for recommendations lists as proposed listings (Fig. 5, paragraphs 0156, 0165-0167) (Presumably, this is limitation (L2).) (Explanatory (L) reference added)

Selecting similar items are from plurality of similar listings and displayed to a user (Figs. 11-12, paragraphs 004, 0061). (Presumably, this is Limitation (L7).) (Explanatory (L) references added).”

Applicants respectfully disagree with the above quotation from the Final Office Action for the reasons discussed below.

**A. Dicker does not teach Limitation (L1): “receiving a category selection from a seller.”**

Dicker teaches that the system selects (does not “receive” as required by the claim) items from a buyer’s shopping cart content (not from the seller as required by the claim limitation) in order to make recommendations to a buyer for ultimate purchase.

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<sup>2</sup> See Office Action at page 12, lines 6-12.

Therefore, Dicker does not teach “receiving a category from a seller” as required by Limitation (L1). This is seen from Dicker’s statement,<sup>3</sup> “An improved user interface and method are provided for presenting recommendations to a user when the user adds an item to a shopping cart.... (e.g., recommendations based on shopping cart contents, recommendations based on purchase history, etc.)....”

Since the user is adding items to a shopping cart, Dicker’s user is a buyer, not a seller (as the claim limitation requires.) The reason this distinction is important is because Limitation (L2), discussed next below, requires “verifying the category supports automated generation for proposed listings. But only sellers generate listings so only sellers, not buyers, would have an interest in verifying that a category supports automatically generating a listing.

Therefore the distinction between buyer and seller is important, and since Dicker does not teach receiving a category from a seller Dicker cannot teach Limitation (L1).

**B. Dicker does not teach Limitation (L2): “verifying the category supports automated generation for proposed listings.”**

Applicants’ representative has studied Fig. 5 and has carefully read paragraphs [0156] and [0165]-[0167] that were cited in the Final Office Action<sup>4</sup> as showing verifying that the category supports automated generation for proposed listing. Nowhere in Fig. 5 or in the cited paragraphs [0156] and [0165] is there any verification function. What Dicker discusses is identifying popular items that have been purchased by the user from a particular shopping cart. This is seen in Dicker’s abstract. It’s also seen in [0167], cited in the Final Office Action, which states, “In step 192 one or more items are optionally selected from the recent shopping cart contents....” (Emphasis added). Thus, Dicker teaches selecting individual items that have been placed in a shopping cart, not verifying that a category supports automated generation for proposed listings as the claim limitation requires. Further, and as discussed above with respect to Limitation (L1), one would not expect a buyer (which is all Dicker discloses) to verify that a

<sup>3</sup> See Abstract of Dicker.

<sup>4</sup> See middle quotation at page 13 of this paper; see also Final Office Action at Page 12, lines 6-12

category supports automated generation for proposed listings. Why? Again, because buyers do not generate listings; sellers generate listings.

Applicants respectfully submit that the Examiner's allegation is erroneous and that Dicker does not teach limitation (L2).

**The Applicable Law under 35 U.S. C. § 103**

As the Board knows, the U.S. Supreme Court decision in *KSR Int'l Co. v. Teleflex Co.*, 550 U.S. 398 (2007), provides a tripartite test to evaluate obviousness. A rationale to support a conclusion that a claim would have been obvious is **that all the claimed elements were known in the prior art** and one skilled in the art could have combined the elements as claimed by known methods **with no change in their respective functions**, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art.

***A. Dicker Fails To Teach Two Limitations of Claim 1 and Therefore Does Not Teach All Elements of the Claims.***

The above required rationale is missing from the Final Office Action because, as illustrated above, Dicker fails to teach two of the limitations of independent claim 1 (Limitations (L1) and (L2)) which the Final Office Action admits is not found in the primary reference (Boyden). Therefore, all elements of the claims, that the Final Office Action asserts to exist in the combination of Boyden and Dicker, do not exist in the suggested combination. Stated another way, all claim elements were not known in the prior art. Therefore the combination of Boyden and Dicker fails to meet the all elements requirements of KSR. Thus, Applicants respectfully request that the claim rejections under 35 U.S.C. §103(a) be reversed as to independent claims 1 and 13. Since each dependent claim contains the limitations of the independent claim from which it depends, the above arguments apply to the dependent claims of independent claims 1 and 13, and none of the other cited prior art cures (or are alleged to cure) the defects cited above, Applicants request that the rejections be withdrawn from the dependent claims as well.



***B. Even if Dicker and Boyden, When Combined, did Teach All Elements of the Claims, a Skilled Artisan would Still not be Motivated to Combine the Teachings of Boyden with the Teachings of Dicker***

The MPEP at 2141 states:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that '[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'

***The Rejection Does not Meet the Articulated Reasoning Requirements of KSR and of the MPEP***

The Final Office Action does not contain articulated reasoning with some rational underpinning to support the legal conclusion of obviousness as required by KSR, and also as required by the MPEP's interpretation of KSR. In fact, the Final Office Action gives what Applicants believe is a clearly erroneous reason for combining Dicker with Boyden. The Final Office Action states:<sup>5</sup>

It would have been obvious to a person of an ordinary skill in the art at the time the invention was made to apply Dicker's teaching of receiving a category selection from a user and verifying the category supports automated generation for recommendation lists and selecting similar Items and displaying similar items to Boyden's system in order to allow a user to select a particular similar item listing so that (1) the service can retrieve

<sup>5</sup> See Final Office Action at page 12, line 13 to page 13, line 6

**another similar item list based [upon] the selected similar list and (2) further to predict the interest of user based on the user's indication so that the system provides a recommendation of similar items based on the interests of users.**

The precise meaning of the above quotation in the Final Office Action is not clear because the underscored lines above simply do not state the limitations or the functions of the claim. Therefore the quotation from the Final Office Action cannot be “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” as required by both KSR and by the MPEP because the reason given for combining Boyden and Dicker is the wrong reason for combining them. It results in the wrong limitations.

As a first example of this, the above-underlined quotation from the Final Office Action illustrates a basic misunderstanding of the claim. More specifically, the statement from the above quotation<sup>6</sup> that illustrates that that misunderstanding is:

apply Dicker’s teaching of receiving a category selection from a user and verifying the category supports automated generation for recommendation lists and selecting similar Items and displaying similar items to Boyden’s system in order to allow a user to select a particular similar item listing so that (1) the service can **retrieve another** similar item list based [upon] the selected similar list

But nowhere in the claim is there a limitation for “selecting similar items and displaying similar items in order to allow a user to select a particular similar item listing so that the service can **retrieve another** similar item list based [upon] the selected similar list” as the above quotation from the Final Office Action asserts. This is simply a misunderstanding of the functioning of the claim.

What the claim actually says (in limitations (L7) and L8) is:

(L7) receiving an indication from the seller selecting a selected listing from the plurality of similar listings;

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<sup>6</sup> i.e., the quotation at the bottom of page 16 of this paper

(L8) generating a proposed listing to present to the seller, the proposed listing including listing data from the selected similar listing;

That is, once the “indication of the seller selecting a selected listing” is received (L7), there is no further “retrieving of another similar item” in the limitation, as the Final Office Action states. After the seller selects a selected listing in (L7), the next limitation (L8) is generating a proposed listing (not retrieving another similar item). The Final Office Action simply misstates the function of the claim and therefore cannot give an articulated reason with a rational underpinning to support the legal conclusion of obviousness, because its statement of the claim is incorrect in the first place.

As a second example, the above quotation from the Final Office Action says that the reason for the seller’s selecting a particular similar listing is to allow the system

(2) further to predict the interest of user based on the user’s indication so that the system provides a recommendation of similar items based on the interests of the user<sup>7</sup>.... (Emphasis added)

But this is not in the claim at all. The purpose of the seller selecting a particular similar item is not “to predict the interest of the user based on a user’s indication so that the system provides a recommendation of similar items,” as the Final Office Action alleges. There is no prediction anywhere in the claim, nor is there any prediction discussed in the specification. The purpose of the indication from the seller is ultimately found in Limitation (L8):

“generating a proposed listing to present to the seller, the proposed listing including listing data from the selected similar listing.”

There is nothing at all in the claim about “to predict the interest of the user” as in the above quotation from the Final Office Action. At this point in the claim the function is to generate a proposed listing, which does not include predicting anything.

It is apparent from the Final Office Action’s misstatement of the claim and its function in two places that the Examiner misunderstands the claim. By definition, an “articulated reasoning

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<sup>7</sup> See quote from the Final Office Action at the bottom of page 16 of this paper; see also Final office Action at page 12, lines 17-20

with some rational underpinning to support the legal conclusion of obviousness” cannot be based on a misunderstanding of the claim. Therefore, the requirement of KSR, and of the MPEP, that there be a rational underpinning to support the legal conclusion of obviousness, is missing from the Office Action. Applicants therefore again request that the rejections be withdrawn as to independent claims 1 and 13, and their dependent claims.

**Combining Boyden and Dicker would destroy the stated purpose of Dicker**

In addition to failing to meet the requirements of KSR and of the MPEP, combining Boyden with Dicker as suggested in the Final Office Action would require altering Dicker in a way that would destroy the stated purpose of Dicker. Dicker’s system selects recent purchases by the buyer in order to make purchase recommendations to the buyer. The claim limitation under discussion requires that the system receive a category from the seller. To substitute in Dicker the seller for the buyer, as the Final Office Action’s proposed combination would do, destroys Dicker’s stated purpose of presenting purchase recommendations to a buyer for purchase. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), quoted in MPEP § 2143.01.V.

For the above reasons, Applicants request that the rejections be reversed as to independent claims 1 and 13, and their dependent claims.

**CLAIM GROUP II**

Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. (U.S. Publication No. 2003/0036964, hereinafter; “Boyden”) in view of Dicker et al. (U.S. Publication No. 2003/0105682, hereinafter; “Dicker”).

**With regard to claim 23**

Applicants believe it is not obvious to combine the teachings of Boyden with the teachings of Dicker for the reasons discussed below.

**The Rejections Do Not Make Out A Prima Facie Case Of Obviousness**

**BOYDEN IN VIEW OF DICKER**

The Final Office Action states:<sup>8</sup>

Boyden does not explicitly teach the claimed limitation receiving an indication from the seller selecting a selected listing from the plurality of similar listings”.

Assuming, for the sake of argument, that the Final Office Action is correct and that Boyden does teach all claim limitations except the above limitation, the discussion that follows will show that this limitation cannot properly be combined with the teachings of Boyden under 35 U.S.C. § 103.

**The Applicable Law under 35 U.S. C. § 103**

As discussed at page 15 of the paper, the U.S. Supreme Court decision in *KSR Int’l Co. v. Teleflex Co.*, 550 U.S. 398 (2007), provides a tripartite test to evaluate obviousness. A rationale to support a conclusion that a claim would have been obvious is **that all the claimed elements were known in the prior art** and one skilled in the art could have combined the elements as claimed by known methods **with no change in their respective functions**, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art.

***It is not Obvious to Combine the Teachings of Boyden with the Teachings of Dicker***

The MPEP at 2141 states:

The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious**. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be **made explicit**. The Court quoting *In re Kahn*,

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<sup>8</sup> See Final Office Action at Page 21, lines 10-11

441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that '[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'

***The Rejection Does not Meet the Articulated Reasoning Requirements of KSR and of the MPEP***

The Final Office Action does not contain articulated reasoning with some rational underpinning to support the legal conclusion of obviousness as required by KSR, and also as required by the MPEP's interpretation of KSR. In fact, the Final Office Action gives what Applicants believe is a clearly erroneous reason for combining Dicker with Boyden. The Final Office Action states:<sup>9</sup>

It would have been obvious to a person of an ordinary skill in the art at the time the invention was made to apply Dicker's teaching of receiving a category selection from a user and verifying the category supports automated generation for recommendation lists and selecting similar Items and displaying similar items to Boyden's system in order to allow a user to select a particular similar item listing so that (1) the service can retrieve another similar item list based [upon] the selected similar list and (2) further to predict the interest of user based on the user's indication so that the system provides a recommendation of similar items based on the interests of users.

The precise meaning of the above quotation in the Final Office Action is not clear because the underscored lines above simply do not state the limitations or the functions of the claim. Therefore the quotation from the Final Office Action cannot be "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" as required by both KSR and by the MPEP because the reason given for combining Boyden and Dicker is the wrong reason for combining them. It results in the wrong limitations.

<sup>9</sup> See Final Office Action at page 22, lines 1-8

As a first example of this, the above-underlined quotation from the Final Office Action illustrates a basic misunderstanding of the claim. More specifically, the statement from the above quotation that illustrates that misunderstanding is:

apply Dicker's teaching of receiving a category selection from a user and verifying the category supports automated generation for recommendation lists and selecting similar Items and displaying similar items to Boyden's system in order to allow a user to select a particular similar item listing so that (1) the service can **retrieve another** similar item list based [upon] the selected similar list

But nowhere in the claim is there a limitation for "selecting similar items and displaying similar items in order to allow a user to select a particular similar item listing so that the service can **retrieve another** similar item list based [upon] the selected similar list" as the above quotation from the Final Office Action asserts. This is simply a misunderstanding of the functioning of the claim.

What the claim actually says is:

receiving an indication from the seller selecting a selected listing from the plurality of similar listings;

generating a proposed listing to present to the seller, the proposed listing including listing data from the **selected** similar listing;

That is, once the "indication of the seller selecting a selected listing" is received, there is no further "**retrieving of another** similar item" in the limitation, as the Final Office Action states. After the seller selects a selected listing, the next limitation is **generating** a proposed listing (not **retrieving another** similar item). The Final Office Action simply misstates the function of the claim and therefore cannot give articulated reason with a rational underpinning to support the legal conclusion of obviousness because its statement of the claim is incorrect in the first place.

As a second example, the above quotation from the Final Office Action says that the reason for the seller's selecting a particular similar listing is to allow the system

(2) further to predict the interest of user based on the user's indication so that the system provides a recommendation of similar items based on the interests of the user<sup>10</sup> .... (Emphasis added)

But this is not in the claim at all. The purpose of the seller selecting a particular similar item is not "to predict the interest of the user based on a user's indication so that the system provides a recommendation of similar items," as the Final Office Action alleges. There is no prediction anywhere in the claim, nor is there any prediction discussed in the specification. The purpose of the indication from the seller is ultimately found in the following limitation:

generating a proposed listing to present to the seller,  
the proposed listing including listing data from the  
selected similar listing.

There is nothing at all in the claim about "to predict the interest of the user" as in the above quotation from the Final Office Action.

It is apparent from the Final Office Action's misstatement of the claim and its function in two places<sup>11</sup> that the Examiner misunderstands the claim. By definition, an "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" cannot be based on a misunderstanding of the claim. Therefore, the requirement of KSR, and of

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<sup>10</sup> See quote from the Final Office Action at the bottom of page 16 of this paper; see also Final office Action at page 12, lines 17-20

<sup>11</sup> As explained above the two places are:

displaying similar items to Boyden's system in order to allow a user to select a particular similar item listing so that  
(1) the service can retrieve another similar item list based [upon] the selected similar list,

and

(2) further to predict the interest of user based on the user's indication so that the system provides a recommendation of similar items based on the interests of the user



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the MPEP, that there be a rational underpinning to support the legal conclusion of obviousness, is missing from the Office Action.

Applicants therefore request that the rejections be withdrawn as to independent claims 23 and, since the same infirmities apply to combining the prior art cited against the dependent claims of claim 23, Applicants request that the rejections be withdrawn as to those dependent claims as well.

**Combining Boyden and Dicker would destroy the stated purpose of Dicker**

In addition to failing to meet the requirements of KSR and of the MPEP, combining Boyden with Dicker as suggested in the Final Office Action would require altering Dicker in a way that would destroy the stated purpose of Dicker. Dicker's system selects recent purchases by the buver in order to make purchase recommendations to the buyer. The claim limitation under discussion requires that the system receive a category from the seller. To substitute in Dicker the seller for the buyer, as the Final Office Action's proposed combination would do, destroys Dicker's stated purpose of presenting purchase recommendations to a buver for purchase. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), quoted in MPEP § 2143.01.V.

For the above reasons, Applicants request that the rejections be reversed as to independent claim 23, and its dependent claims.

### SUMMARY

For the reasons argued above, independent claims 1 and 13 and their dependent claims were not properly rejected under § 103 as being obvious over Boyden in view of Dicker.

For the reasons argued above, independent claim 23 and its dependent claims were not properly rejected under § 103 as being obvious over Boyden in view of Dicker.

It is respectfully submitted that the art cited does not render the claim anticipated and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claim are respectfully requested.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Appeal Brief – Patents, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 16th day of July, 2010.

Chris Bartl

Name

  
Signature

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## **8. CLAIMS APPENDIX**

1. A method of generating a listing in a network-based commerce system, the method comprising:
  - receiving a category selection from a seller,
  - verifying the category supports automated generation for proposed listings;
  - receiving listing identification data from a seller, the listing identification data capable of being used to identify a good or service;
  - searching a database of listing data using the listing identification data to locate a plurality of similar listings posted within a network-based commerce system;
  - searching the database to locate attribute data;
  - providing information to present the plurality of similar listings and the attribute data to the seller;
  - receiving an indication from the seller selecting a selected listing from the plurality of similar listings;
  - generating a proposed listing to present to the seller, the proposed listing including listing data from the selected similar listing;
  - providing information to present a preview of the proposed listing to the seller;
  - allowing the seller to modify the listing data of the proposed listing to create a listing; and
  - posting the listing in a database of the network-based commerce system, the listing, once posted, representing an offering of the good or service for sale.
2. The method of claim 1, which includes allowing the seller to accept the listing, prior to posting the listing.
3. The method of claim 1, wherein the database of listing data is associated with at least one of movies, music, games, or books.

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4. The method of claim 1, which includes:  
generating a user interface with a plurality of fields; and  
populating the plurality of fields with the listing data.
  5. The method of claim 4, which includes providing a plurality of check boxes, each of which is associated with an attribute of the listing, and automatically without human intervention checking attributes based on the listing data.
  6. The method of claim 5, which includes allowing the seller to modify checks in the check boxes.
  7. The method of claim 1, wherein the listing data includes at least one of a group including a title of the listing, a description of the listing, and an image related to the listing.
  9. The method of claim 1, wherein the listing identification data is a Vehicle Identification Number (VIN), the method including retrieving listing data including at least one of a model year of the vehicle, a manufacturer of the vehicle, a number of doors of the vehicle, or an engine capacity of the vehicle.
  10. The method of claim 1, wherein the listing identification data is at least one of a movie title or a UPC code, the method including retrieving the listing data in the form of details on a movie.
  11. The method of claim 1, wherein the listing identification data is at least one of a book title or a UPC code, the method including retrieving the listing data in the form of details on a book.
  12. The method of claim 1, wherein the listing identification data is at least one of a music title or UPC code, the method including retrieving the listing data in the form of details on a music item.

13. A machine-readable medium including instructions that, when executed by a machine, cause the machine to:

- receive a category selection from a seller;
- verify the category supports automated generation for proposed listings;
- receive listing identification data from a seller requesting posting of a listing on a network-based commerce system, the listing identification data capable of being used to identify a good or service in the category;
- search a database of listing data using the listing identification data to locate a plurality of similar listings posted within a network-based commerce system;
- receive an indication from the seller to select a selected listing from the plurality of similar listings;
- searching the database to locate attribute data;
- providing information to present a preview of the plurality of similar listings and the attribute data to the seller;
- generate a proposed listing to present to the seller, the proposed listing including listing data from the selected similar listing;
- providing information to present the proposed listing to the seller;
- allow the seller to modify the listing data in the proposed listing to create the listing; and
- post the listing in a database of the network-based commerce system, the listing, once posted, representing an offering of a good or service for sale.

14. The machine-readable medium of claim 13, wherein the seller is allowed to accept the listing, prior to posting the listing.

15. The machine-readable medium of claim 13, wherein the database of listing data is associated with at least one of movies, music, games, or books.

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16. The machine-readable medium of claim 13, which causes the machine to:  
generate a user interface with a plurality of fields; and  
populate the plurality of fields with the listing data.
17. The machine-readable medium of claim 16, wherein a plurality of check boxes are provided, each check box being associated with an attribute of the listing and selectively being automatically checked based on the listing data without human intervention.
18. The machine-readable medium of claim 17, wherein the seller is allowed to modify checks in the check boxes.
19. The machine-readable medium of claim 13, wherein the listing data includes at least one of a title of the listing, a description of the listing, or an image related to the listing.
21. The machine-readable medium of claim 13, wherein the listing identification data is a Vehicle Identification Number (VIN) of a vehicle, and the listing data includes at least one of a model year of the vehicle, a manufacturer of the vehicle, a number of doors of the vehicle, or an engine capacity of the vehicle.
22. The machine-readable medium of claim 13, wherein the listing identification data is one of a movie title or a UPC code, and the listing data includes details on a movie.

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23. A network-based commerce system, which includes at least one server to:
- receive listing identification data from a seller requesting posting of a listing on a network-based commerce system, the listing identification data capable of being used to identify a good or service;
  - search a database of listing data using the listing identification data to locate a plurality of similar listings posted within a network-based commerce system;
  - receive an indication from the seller to indicate a selection of a selected listing from the plurality of similar listings;
  - generate a proposed listing to present to the seller, the proposed listing including listing data from the selected similar listing;
  - allow the seller to modify the listing data in the proposed listing to create the listing; and
  - post the listing in a database of the network-based commerce system, the listing, once posted, representing sales offering of a good or service.
24. The system of claim 23, which allows the seller to accept the listing, prior to posting the listing.
25. The system of claim 23, wherein the database of listing data is associated with at least one of movies, music, games, or books.
26. The system of claim 23, wherein the server is to generate a user interface with a plurality of fields, and populates the plurality of fields with the listing data.
27. The system of claim 26, which provides a plurality of check boxes, each of which is associated with an attribute of the listing, and automatically without human intervention checks attributes based on the listing data.
28. The system of claim 27, which allows the seller to modify checks in the check boxes.

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29. The system of claim 23, wherein the listing data includes at least one of a title of the listing, a description of the listing, or an image related to the listing.
31. The system of claim 23, wherein the listing identification data is a Vehicle Identification Number (VIN) of a vehicle, and the listing data includes at least one of a model year of the vehicle, a manufacturer of the vehicle, a number of doors of the vehicle, or an engine capacity of the vehicle.
32. The system of claim 23, wherein the listing identification data is one of a movie title or a UPC code, and the system retrieves the listing data in the form of details on the movie.
33. The system of claim 23, wherein the listing identification data is one of a book title or a UPC code, and the system retrieves the listing data in the form of details on the book.
34. The system of claim 23, wherein the listing identification data is one of a music title or a UPC code, and the system retrieves the listing data in the form of details on the music.
35. The method of claim 1, wherein the offering includes an auction listing.
36. The method of claim 1, wherein the offering includes a fixed-price offering.
39. The method of claim 1, wherein the database of listing data includes motor vehicle data.
40. The machine-readable medium of claim 13, wherein the database of listing data includes motor vehicle data.
41. The system of claim 23, wherein the database of listing data includes motor vehicle data.



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42. The method of claim 35, the method further comprising:  
receiving a modification for the listing from the seller when there are no bids for the  
auction listing; and  
modifying the auction listing; and  
reposting the auction listing in the database.
43. The method of claim 42, the method further comprising:  
receiving a modification for the listing from the seller before a close of the auction  
listing; and  
supplementing the auction listing; and  
reposting the auction listing in the database.
44. The method of claim 1, further comprising:  
receiving a second category selection from the seller.
45. The method of claim 1, further comprising:  
populating a template with data from the selected listing and the attribute data; and  
providing information to present the template to the seller.

## **9. EVIDENCE APPENDIX**

None.

## **10. RELATED PROCEEDINGS APPENDIX**

None.